

REMARKS / ARGUMENTS

Reconsideration of the above-identified application respectfully requested.

With the present response, one claim has been amended. In claim 1, the article "an" has been changed to --a--. This amendment corrects an inadvertent typographical error. The word --structural-- has been added before "automobile part" in step (c) of claim 1 to provide proper antecedent basis. No new matter is added by virtue of these claim amendments. Moreover, such claim amendments are ministerial in nature involving only the correction of typographical error and provision of proper antecedent basis. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 US 722, 112 S.Ct. 1831, 152 L.Ed.2d 944, 62 USPQ2d 1705 (2002)). See also *Interactive Pictures Corp. v. Infinite Pictures Inc.*, 274 F.3d 1371, 61 USPQ 1152 (Fed. Cir. 2001) (addition of the words "transform calculation" was not a narrowing amendment because that addition did nothing more than make express what had been implicit in the claim as originally worded).

A great number of packaging systems exist for packaging various articles for various purposes. For example, gifts are packaged within boxes wrapped in festive paper tied with ribbons and bows. The purpose of packaging gifts is to make them aesthetically pleasing to the recipient. Food is packaged, for example, in paper, cardboard, shrink-wrap, Styrofoam, or combinations thereof, to provide aseptic or bacterial protection. Food also may be packaged for the purpose of preventing dehydration or oxidation, which will make the food either unappealing or spoiled and unfit for consumption. Products formed from metal may be coated or otherwise packaged to prevent oxidation, which for these products results in rust.

Unlike the above-described packaging systems, the present invention is addressed packaging structural automobile parts for shipping. As noted in the application at page 4, lines 10-19:

When the object is large and heavy, such as an automobile structural part, proper packing for its safe shipment is anything but routine. Even "unbreakable" structural automobile parts, such as hoods, fenders, and doors, can become scratched, dented, and abraded to the point that rework of the part is needed. When the structural automobile parts are breakable and non-planar, such as automobile windshield glass, the packing problems become even more compounded. Now, the packer must be attentive to scratching, abrading, breaking, and stress, of a part that can weigh upwards to several hundred pounds. A daunting task for the part manufacturer and shipper indeed.

Thus, a "structural automobile part" as used in the application does not simply mean a part having a structure.

At present, structural automobile parts may be shipped via common carrier by ground, by air, or by freight. The parts invariably will be handled by both employees and transport machinery. The parts must be protected from the elements, including precipitation and extreme heat and cold. The parts are subject to being thrown, dropped, bumped, kicked, etc. They must withstand the damage caused by grasping or lifting equipment and conveyors. They may have potentially heavy packages placed upon them while in storage or transport.

The packaging in which easily damaged parts are contained must withstand all of these potential hazards and prevent the above-noted breakage, scratches, and dents. The inventors discovered that the structural protection needed could be achieved by placing a structural automobile part on the front of a paperboard, leaving a portion of the paperboard exposed, and shrink-wrapping the structural automobile part to the paperboard and the exposed areas. This method produced surprising and unexpected results given the simplicity of the packaging materials and the disparity of size and weight between the packaging materials and the parts to be packaged. These surprising and unexpected results are discussed in greater detail below in connection with the attached declaration of Mr. Youell.

Turning to the claim rejections, it is noted that claim 1 stands rejected under 35 U.S.C. § 102 as being anticipated by Meyer, U.S. Patent No. 3,784,004. In applying this rejection, the Examiner has stated that Meyer discloses a paperboard 12 having a front and back, placing an automobile part 14 that has a structure on the front of the paperboard, leaving front areas exposed, and shrink wrapping the part onto the paperboard with film 16. Office action at page 3.

Meyer discloses an airtight packaging, the purpose of which is to prevent air and moisture from either entering or leaving a chamber containing the packaged article. The packaging consists of a paperboard substrate 12, extending over the surface of which is coating 20. Positioned on top of the coated paperboard substrate is article 14. Film 16 is applied over article 14 and the exposed areas of paperboard 12. When the temperature is elevated, film 16 melts so that it can be vacuum-formed. The heat is also sufficiently high to melt the portions of coating 20 surrounding, but not under, article 14. Melted coating 20 also permeates portions of paperboard substrate 12 so that a vacuum draw is

permeated through the substrate. Thus, a normally porous substrate is made air-impervious to provide additional protection to the article contained within the resulting chamber. Meyer's packaging is intended to protect articles from damage caused by exposure to air and moisture. Thus, the disclosed categories of articles to be contained within the packaging are foods that require protection from spoiling and metal products that require protection from corrosion. Meyer at Col. 3, lines 10-14 and Col. 5, lines 39-43.

Meyer does not disclose or teach a method for packaging a structural automobile part for shipment. In particular, Meyer does not teach the step (b) of "placing a structural automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard". (emphasis added). Meyer also does not teach step (c), which calls for "shrink-wrapping with plastic shrink wrap material said structural automobile part to said paperboard and said exposed areas of said front of said paperboard". (emphasis added). Meyer also does not disclose packaging for the purpose of shipping.

Practicing the claimed method does not simply protect a product against air and moisture. Rather, the present method protects the integrity of structural automobile part when transported under conventional shipping conditions. Thus, the invention solves an entirely different problem from that addressed in Meyer. Meyer does not teach or disclose a packaging designed for shipping. Shipping or other transportation of articles is nowhere mentioned in Meyer. Even assuming, *arguendo*, that Meyer teaches a shipping package, which it does not, Meyer no where discloses that its packaging can be used for structural automobile parts. To the contrary, the "articles" disclosed in Meyer are either foods and automobile parts that are robust and not easily damaged. In this regard, the automotive parts of Meyer are similar to the spark plug disclosed in Engles, U.S. Patent No. 3,154,898. Examples of parts that may be packaged with the Meyer system include bearings and clutches. Meyer at Col. 5, lines 39-43. Most importantly, the automotive parts identified in Meyer are ones that are formed from or have a coating of material that may corrode. Packaging the parts in the Meyer packaging, "provides corrosion protection by preventing moisture entering the chamber 18. *Id.*

Before turning to the 35 U.S.C. § 103 rejections, Applicants would like to call the Examiner's attention to the attached declaration of Donald R. Youell, Jr. Mr. Youell has been involved in the manufacture and design of corrugated packaging for 45 years and is a co-inventor and co-applicant of the present application. Mr. Youell also is president of American Corrugated Products (ACP), which manufactures and sells packaging to be

used in accordance with the method of claims 1-5. Since the packaging was introduced about a year ago, ACP has experienced phenomenal commercial success. ACP's customers include, among others, Daimler Chrysler and Mac-Pack.

Attached to Mr. Youell's declaration are two letters received from customers regarding their experiences with prior art shipping packages and those of the present invention. These letters are representative of the response customers have had to ACP's packaging design. The first letter, attached to Mr. Youell's declaration, is from Richard Tracy. Mr. Tracy is the purchasing agent for Daimler Chrysler, which, as noted above, is one of ACP's customers. As indicated by Mr. Tracy, the breakage rate for laminated glass products is traditionally high in a single pack application. However, with the ACP design, Daimler Chrysler's breakage is down considerably and they are able to ship more single packs to customers with the confidence that the parts will arrive intact. Mr. Tracy also states that ACP's unique design completely protects the sealing surfaces from damage and is the only packaging that Mr. Tracy has seen that offers that ability.

The second letter, attached to Mr. Youell's declaration as Exhibit B, is from Daniel McLaughlin, president of Mac-Pack Services, Inc., which is another ACP customer that specializes in packaging aftermarket automotive glass products. Mr. McGlaughlin, like Mr. Tracy, recognizes that, historically, the glass packing portion of the business has resulted in a high percentage of damaged and broken glass during the shipping phase. Since Mac-Pack Services has been a customer of American Corrugated Products, the claims for broken and damaged shipments has decreased by 90%. He further states that use of the ACP design has been so successful that Mac-Pack Services' business with automotive companies and glass manufacturers has increased 300%.

Applicants respectfully request that the Examiner consider the commercial success of ACP's shipping method as evidenced by Mr. Youell's declaration and find that the invention is non-obvious in view of the cited prior art.

Turning now to the rejections under 35 U.S.C. §103(a), it is noted that claim 2 stands rejected over Meyer in view of Gillio-tos, U.S. Patent No. 4,611,456. The Examiner cites Gillio-tos as disclosing that it is old and well-known in the art to use a backing that can be comprised as a laminate as a means of increasing product durability.

Gillios-tos does not make up for the deficiencies of Meyer. Like Meyer, Gillios-tos does not disclose a packaging that is designed for "shipping said shrink-wrapped structural automobile part." Gillio-tos' packaging, like Meyer, is directed to protecting the packaged article from air and moisture. Also like Meyer, Gillio-tos does not disclose packaging for structural automobile parts. Automobile parts are nowhere mentioned in

Gillio-tos and food and automobile parts clearly are not interchangeable products for packaging and shipping purposes. The combination of Meyer and Gillos-tos, two patents addressed to packaging primarily for vacuum sealing food, would not have suggested to the skilled artisan that structural automobile parts could be packaged and shipped safely encased in plastic shrink wrap on laminate paperboard. That structural automobile parts can be shipped in those materials clearly is unexpected and surprising. In the almost 20-30 years since the Meyer and Gillios-tos patents issued, no one has applied such shrinking wrapping techniques for packaging and shipping large, bulky, and/or breakable automotive items. For these reasons, claim 2 is not obvious in view of Meyer, Gillos-tos, or the combination of the two.

It is noted that claims 3 and 4 also have been rejected under 35 U.S.C. § 103(a). These claims have been rejected as being obvious over Meyer in view Engles, Jr., U.S. Patent No. 3,154,898. In particular, the Examiner defines "structural automobile part" as "a part having structure."

A structural automobile part is not a merely a part having a structure. As noted above, the application defines a "structural automobile part" as meaning a large and heavy automobile part, which may be unbreakable or breakable. Application, page 4, lines 7-19. Examples of unbreakable structural automobile parts are hoods, fenders, doors, and the like. Breakable may be, for example, automobile windshields. Whether breakable or unbreakable, these parts generally are difficult to ship because they are easily damaged (i.e., scratched, dented, broken, etc.). With this definition, it may be seen that Engles, Jr. does not disclose a structural automobile part. Engles, Jr. discloses packaging for a spark plug, which is a small, robust part that is not easily damaged. Further, even for such a small part, Engles, Jr. teaches that paperboard is insufficient to provide a suitable backing for shipping. Rather, Engles, Jr. teaches that packaging of such parts requires a foam backing, which acts to cushion the packaged article. Thus, Engles, Jr. not only is missing one of the claimed features of the claims, i.e., a structural automobile part, it teaches away from a second feature, namely, the use of paperboard as a backing or substrate.

With respect to claim 4, the Examiner takes Official Notice that it is inherent in the reference of Meyer to package automobile parts comprised of window glass, door panels, hoods, fenders, *etc.* Applicants first respectfully traverse the Examiner's Official Notice and request that the Examiner produce evidence that, for shipping purposes, window glass, door panels, hoods, and fenders are equivalent to or interchangeable with clutches and bearings. Disclosure that a certain packaging is suitable for one type

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of automobile part is not inherent disclosure that that same packaging can be used for any automobile part. Further, even if Meyer's packaging could be used to ship window glass, door panels, hoods, fenders, etc., there is no disclosure to do so. A new use for a known product is patentable if the use produces surprising and unexpected results as is the case here.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Wilkinson, U.S. Patent No. 6,010,003. Wilkinson does not make up for the deficiencies of Meyer. It does not disclose a method for shipping structural automobile parts. Therefore, Applicants submit that claim 5 is patentable for the reasons given above in connection with claim 1.

Respectfully submitted,

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